

REMARKS

The new Office Action mailed December 3, 2003 rejected claims 33 and 62 under Section 102(e) as anticipated by Frey (6,369,908). Further, claims 1-3, 5, 8-9, 17-22, 24, 26, 44-45, 48, 50, 56-61 and 63-64 were rejected as unpatentable over Frey, Ofoto and Rogan (5,710,466). Additionally, claims 34-43 were rejected under Section 103 as unpatentable over Frey and Ofoto. Claims 4, 6-7, 10-16, 23, 25, 27-32, 46-47, 49 and 51-55 were rejected as unpatentable over Frey, Rogan, Ofoto, and Official Notice.

As discussed below, Applicants traverse the rejections and respectfully submit that all claims are in condition for allowance.

The Section 102 Rejection

Claims 33 and 62 were rejected under Section 102(e) as anticipated by Frey. Both claims 33 and 62 recite the following:

means, in response to receipt of a first poll request at the kiosk and if a data structure is available, for sending data structure address information corresponding to available data structure from the kiosk via the communications medium; and
_____ in response to receipt of the sent data structure address information at the image-processing provider, sending a data-structure-fetch request across the communications medium to the kiosk.

Frey is completely silent on the foregoing elements. The Office Action points to the Abstract and Col. 1, lines 54-59 as showing the claimed specifics. The Frey Abstract discloses a photo kiosk with a camera that takes a picture of the user which is converted into an electronic image. The user can selectively add to the electronic image a banner message, a text message, and/or an audio message. The electronic image, optional banner message, optional text message, and optional audio message are combined into an electronic file. The user can save the electronic file on a removable electronic storage device or can send the electronic file to an electronic address which the user inputs. The photo kiosk can perform system utilities and diagnostics and send the results to a remote location. One can access the photo kiosk from a remote location to perform maintenance and repair. Alternatively, one can perform diagnostics, system utilities, maintenance, and repair on the photo kiosk while at the site of the photo kiosk.

Col. 1, lines 54-59 discloses that the user can transmit the electronic image created, as well as any added text message, audio data, and other visual image, via electronic transmission, such as over the Internet or other similar network of computers.

Frey merely shows a kiosk that takes a digital picture and emails the picture to a recipient. However, Frey does not show the specifics of receiving a first poll request and sending data structure address information corresponding to available data structure from the kiosk. Nowhere in Frey does it show this aspect, and the Section 103 rejection below admits that the element is missing. Since at least this element is missing, and the Office Action cannot point to the claimed specifics in Frey, the rejection should be withdrawn for this reason alone.

Frey also does not show sending a data-structure-fetch request across the communications medium to the kiosk. Since this element is missing, and the Office Action cannot point to the claimed specifics in Frey, the rejection should be withdrawn for this second independent reason for traversing the rejection.

Since Frey lacks at least two elements of the claimed invention, it cannot anticipate the independent claims and those dependent therefrom. Withdrawal of the Section 102 rejection is respectfully requested.

The Section 103 Rejection

Claims 1-3, 5, 8-9, 17-22, 24, 26, 44-45, 48, 50, 56-61 and 63-64 were rejected as unpatentable over Frey, Ofoto and Rogan. Applicants respectfully traverse the rejection. Here, the references fail to show a number of elements recited in the claims.

First, neither Frey, Ofoto, nor Rogan discloses storing into a local storage connected to the computer, a digital representation of the image information and associated user identifier information and order information for each of a plurality of different customers into a data structure.

At best, Frey shows capturing a picture, sound clip and text of one user and emailing the captured data to an email address. Frey also mentions that the kiosk includes a payment device at Col. 6, lines 9-16. However, Frey does not show the claimed element of storing order information for each of a plurality of different

customers into a data structure. Since this element is missing, Frey cannot render the independent claims obvious.

Additionally, the Office Action acknowledged that Frey did not show, in response to receipt of a first poll request at the kiosk and upon detecting the availability of the data structure, sending data structure address information corresponding to the available data structure from the kiosk to the image-processing provider via the communications medium; in response to receipt of the sent data structure address information at the image-processing provider, sending a data-structure-fetch request across the communications medium from the image-processing provider to the kiosk; sending the data structure to the image-processing provider via a communication medium, and storing the data structure in the image-processing provider.

The Office Action asserted that Rogan and Ofoto disclose the missing elements. Applicants traverse the assertion. Rogan relates to a high-capacity high-speed storage/retrieval system for storage and retrieval of document images in digitized data form permits clusters of storage/retrieval modules (SRM's) to store and exchange digital data via local area networks within the cluster of SMR's. Rogan's Col. 7, lines 26-29 discloses that the disk controller board 10dc receives the image packet and prepares it for transmittal to the disk drive location which was defined by the Storage Processor 10p. Data is then transferred from the disk controller board 10dc to the disks 20. The image packet is stored on the disk until the SRM module 10 receives a request to retrieve the selected image packet or group of packets. Image packets are retrieved through a read and transfer of the packet data. The image data which is stored on the disk is not altered or erased.

However, Rogan still does not disclose the claimed specifics, namely in response to receipt of a first poll request at the kiosk and upon detecting the availability of the data structure, sending data structure address information corresponding to the available data structure from the kiosk to the image-processing provider via the communications medium; in response to receipt of the sent data structure address information at the image-processing provider, sending a data-structure-fetch request across the communications medium from the image-processing provider to the kiosk;

sending the data structure to the image-processing provider via a communication medium, and storing the data structure in the image-processing provider.

These claims overcome the Section 103 rejection because they depend from allowable independent claims. Further, Applicants note that the MPEP Section 2143.01 - Suggestion or Motivation To Modify the References – has pronounced that a statement that modifications of the prior art to meet the claimed invention would have been " 'well within the ordinary skill of the art at the time the claimed invention was made' " because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. Applicants note that no motivation or suggestion, either in the cited art reference or in the knowledge generally available to one of ordinary skill in the art, has been cited by the Examiner to modify the Frey reference so as to produce the claimed invention.

The Office Action then noted that "assuming Frey and Rogan do not expressly teach sending the data structure to the image-processing provider via a communication medium, Ofoto overcomes this ostensible deficiency."

Applicants have carefully reviewed the Ofoto PR Newswire dated Dec. 13, 1999, and could not locate any discussion of sending a data structure having a digital representation of the image information and associated user identifier information and order information for each of a plurality of different customers. At best, Ofoto simply shows that a user can order only the images they like. However, this is significantly different from storing order information for each of a plurality of different customers in a marker file.

Additionally, Ofoto fails to show other missing elements, namely in response to receipt of a first poll request at the kiosk and upon detecting the availability of the data structure, sending data structure address information corresponding to the available data structure from the kiosk to the image-processing provider via the communications medium; in response to receipt of the sent data structure address information at the image-processing provider, sending a data-structure-fetch request across the communications medium from the image-processing provider to the kiosk;

sending the data structure to the image-processing provider via a communication medium, and storing the data structure in the image-processing provider.

Based on the foregoing, Applicants submit that Frey, Ofoto and Rogan, singly or in combination, cannot render unpatentable claims 1-3, 5, 8-9, 17-22, 24, 26, 44-45, 48, 50, 56-61 and 63-64.

Claims 34-43 were rejected under Section 103 as unpatentable over Frey and Ofoto. As discussed above, Frey and Ofoto, singly or in combination, cannot render unpatentable claims 34-43.

Claims 4, 6-7, 10-16, 23, 25, 27-32, 46-47, 49 and 51-55 were rejected as unpatentable over Frey, Rogan, Ofoto, and Official Notice. Applicants note that no motivation or suggestion, either in the cited art reference or in the knowledge generally available to one of ordinary skill in the art, has been cited by the Examiner to modify the Frey reference so as to produce the claimed invention.

As noted above, the Frey reference fails to teach or suggest collecting images from a plurality of customers into a kiosk, and transferring images from the kiosk to an image-processing provider. The PR reference news article fails to teach or suggest collecting images from a plurality of customers into a kiosk, and transferring images from the kiosk to an image-processing provider.

Further, Applicants fail to identify any motivation to modify the reference teaching so as to provide transferring images from the kiosk to an image-processing provider as presently claimed. In fact, the Frey reference teaches away from Applicant's invention as one skilled in the art would have been generally discouraged from transferring images from the kiosk to an image-processing provider since Frey expressly teaches sending data one at a time to an email address.

Applicants point out that the Examiner bears the initial burden of factually establishing and supporting any *prima facie* conclusion of obviousness. *In re Rinehart*, 189 U.S.P.Q. 143 (CCPA 1976); M.P.E.P. § 2142. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of nonobviousness. *Id.* In the instant case, the Examiner has not pointed to any evidence in Frey, or how knowledge of those skilled in the art, provide a suggestion or motivation to modify the reference teaching so as to produce the claimed invention. See *In re Zurko*,

59 U.S.P.Q.2d 1693 (Fed. Cir. 2001) ([I]n a determination of patentability the Board cannot simply reach conclusions based on its understanding or experience - or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings).

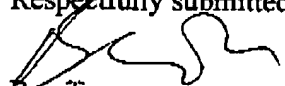
Under *Vaeck*, absent any evidence of a cited suggestion or reasonable motivation in the Andreiko et al. reference, or knowledge of those skilled in the art, for interpolating positional differences to produce successive digital data sets of tooth arrangements, *prima facie* obviousness of the claims has not been established. As such, it is respectfully requested that the § 103(a) rejection of claims, 6, 7, 10-16, 23, 25, 32, 46, 47, 49 and 51-55 be withdrawn and the claims be allowed. Similarly, the § 103(a) rejection of claims 9, 24, 34, 35 and 37-43 should be withdrawn.

CONCLUSION

Applicants believe that the above discussion is fully responsive to all grounds of rejection set for the in the Office Action.

If for any reasons the Examiner believes a telephone conference would in any way expedite resolution of the issues raised in this appeal, the Examiner is invited to telephone the undersigned at 408-528-7490.

Respectfully submitted,


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